

### **REMARKS**

This is a full and timely response to the outstanding non-final Office Action mailed May 18, 2005. Through this response, independent claims 9 and 24 have been amended and dependent claims 15, 16, 30, and 31 have been canceled without prejudice, waiver, or disclaimer. Reconsideration and allowance of the application and pending claims 1-14, 17-29, and 32 are respectfully requested.

#### **I. Drawings Objection**

The drawings have been objected to under 37 C.F.R. 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 176 (figure 1), 416 (figure 4).

In response to this objection, the specification has been amended to incorporate the reference numerals shown in the figures. No new matter has been added.

In view of the above-noted amendments to the drawings, Applicants respectfully submit that the drawings are acceptable and respectfully request that the objection be withdrawn.

#### **II. Specification Objections**

The specification has been objected to for containing various informalities. Specifically, the Office Action states the following:

The disclosure is objected to because of the following informalities: minor typographical errors.

On page 8 (line 21), the ADIC 102 to light drive element 142 connection is described as connection 143; however, figure 1 shows that the connection is 243.

On page 13 (line 23), reference numeral 318 is described in reference to figure 3A, but is not shown in the figure. However, reference numeral 316 is shown in the figure, but is not described in the specification. Reference numeral 318 should be changed to 316.

On page 14 (line 18), reference numeral 368 is described in reference to figure 3B, but is not shown in the figure. However, reference numeral 366 is shown in the figure, but is not described in the specification. Reference numeral 368 should be changed to 366.

Appropriate correction is required.

Through this response, Applicants have amended FIG. 1 to change "243" to "143." Also, as described above, Applicants have amended pages 13 and 14 to correct the inaccuracies noted above.

In view of the above-noted amendments to the specification and FIG. 1, Applicants respectfully submit that the specification is acceptable and respectfully request that the objection be withdrawn.

### **III. Specification Amendments**

Various amendments have been made to the specification through this Response to correct typographical and grammatical errors, and to provide a correct and accurate description of Applicants' invention as originally disclosed. Although these amendments effect several changes to the specification, no new matter has been added.

### **IV. Abstract Objection**

The Office Action alleges the following with regard to the Abstract:

The abstract of the disclosure has been objected to the form and legal phraseology often used in patent claims, such as "means", "comprises", and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Through this Response, all such legal language has been removed. In view of these amendments, Applicants respectfully request that the objection be withdrawn.

**V. Claim Rejections - 35 U.S.C. § 102(e)**

**A. Statement of the Rejection**

Claims 9-13, 15, 16, 24-28, 30 and 31 have been rejected under 35 U.S.C. § 102(e) as allegedly anticipated by *Monti* (“*Monti*,” U.S. Pat. No. 6,680,748). Applicants respectfully traverse this rejection.

**B. Discussion of the Rejection**

It is axiomatic that “[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration.” *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983). Therefore, every claimed feature of the claimed invention must be represented in the applied reference to constitute a proper rejection under 35 U.S.C. § 102(e).

In the present case, not every feature of the claimed invention is represented in the *Monti* reference.

**Independent Claim 9**

Claim 9 recites (with emphasis added):

9. A method for capturing and embedding high-resolution still image data in a sequence of video data, comprising:

capturing a sequence of video data during a first mode of operation, the sequence of video data captured at a first resolution;

entering into a second mode of operation, the second mode of operation being at a second resolution, the second resolution being greater than the first resolution;

capturing data at the second resolution;

***dividing the sequence of video data captured during the first mode of operation into video frames;***

*dividing the data generated at the second resolution into still frames; and sequentially alternating the video frames and the still frames; and*  
storing the data captured at the second resolution.

Applicants respectfully submit that *Monti* does not disclose at least the emphasized claim features. Applicants have amended independent claim 9 to incorporate the features of claim 15, and have canceled claim 15 and 16, the latter to make consistent with amended claim 9. Thus, the following discussion will address the Office Action assertions made in claims 9 and 15. In page 6 of the Office Action with regard to claim 15, the Office Action states the following (no emphasis added):

As for Claims 15 and 30, *Monti* discloses, as shown in figure 2B and as stated in column 5 (line 66) – column 6 (line 1-11), logic for dividing the sequences of video data captured during the first mode of operation into video frames (220); logic for dividing the data generated at the second resolution into still frames (224); and logic for sequentially alternating the video frames and the still frames (see figures 2B and 2C).

Applicants respectfully disagree. In column 6, line 5, *Monti* provides that the “video image is one frame, field, or section in a video stream.” In column 6, line 55, the reference numeral 220 is associated with a video stream, not video frame. The prior cited section (col. 6, line 55) makes it clear that a video stream is not a video frame. Thus, it cannot be said that *Monti* discloses *dividing the sequence of video data captured during the first mode of operation into video frames*, since no such delineation is apparent. Further, and related to the above discussion, is that video frames that comprise a stream or at least a portion of a stream appear consecutively in FIGs. 2B and 2C, and not alternating sequentially between video and still *frames* as required by independent claim 9. For at least these reasons, Applicants respectfully submit that *Monti* does not disclose the above emphasized features, and thus respectfully request that the rejection to independent claim 9 be withdrawn.

Because independent claim 9 is allowable over *Monti*, dependent claims 10-14 and 17 are allowable as a matter of law for at least the reason that the dependent claims 10-14 and 17 contain all elements of their respective base claim. See, e.g., *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

#### **Independent Claim 24**

Claim 24 recites (with emphasis added):

24. A computer readable media having a program for capturing and embedding high-resolution still image data in a sequence of video data, the program comprising logic for:

capturing a sequence of video data during a first mode of operation, the sequence of video data captured at a first resolution;

entering into a second mode of operation, the second mode of operation being at a second resolution, the second resolution being greater than the first resolution;

capturing data at the second resolution;

storing the data captured at the second resolution;

***dividing the sequence of video data captured during the first mode of operation into video frames;***

***dividing the data generated at the second resolution into still frames; and***

***sequentially alternating the video frames and the still frames.***

Applicants respectfully submit that *Monti* does not disclose at least the emphasized claim features. Applicants have amended independent claim 24 to incorporate the features of claim 30, and have canceled claim 30 and 31, the latter to make consistent with amended claim 24. Thus, the following discussion will address the Office Action assertions made in claims 24 and 30. In page 6 of the Office Action with regard to claim 30, the Office Action states the following (no emphasis added):

As for Claims 15 and 30, *Monti* discloses, as shown in figure 2B and as stated in column 5 (line 66) – column 6 (line 1-11), logic for dividing the sequences of video data captured during the first mode of operation into video frames (220); logic for dividing the data generated at the second resolution into still frames (224); and logic for sequentially alternating the video frames and the still frames (see figures 2B and 2C).

Applicants respectfully disagree. In column 6, line 5, *Monti* provides that the “video image is one frame, field, or section in a video stream.” In column 6, line 55, the reference numeral 220 is associated with a video stream, not video frame. The prior cited section (col. 6, line 55) makes it clear that a video stream is not a video frame. Thus, it cannot be said that *Monti* discloses *dividing the sequence of video data captured during the first mode of operation into video frames*, since no such delineation is apparent. Further, and related to the above discussion, is that video frames that comprise a stream or at least a portion of a stream appear consecutively in FIGs. 2B and 2C, and not alternating sequentially between video and still *frames* as required by independent claim 24. For at least these reasons, Applicants respectfully submit that *Monti* does not disclose the above emphasized features, and thus respectfully request that the rejection to independent claim 24 be withdrawn.

Because independent claim 24 is allowable over *Monti*, dependent claims 25-29 and 32 are allowable as a matter of law.

Due to the shortcomings of the *Monti* reference described in the foregoing, Applicants respectfully assert that *Monti* does not anticipate Applicants’ claims. Therefore, Applicants respectfully request that the rejection of these claims be withdrawn.

## **VI. Claim Rejections - 35 U.S.C. § 103(a)**

### **A. Rejection of Claims 1-8, 14, 18-23 and 29**

Claims 1-8, 14, 18-23 and 29 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Monti* in view of *Hori* (“Hori,” U.S. Pat. No. 5,991,504). Claims 17 and 32 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Monti*. Applicants respectfully traverse these rejection.

**B. Discussion of the Rejection**

As has been acknowledged by the Court of Appeals for the Federal Circuit, the U.S. Patent and Trademark Office (“USPTO”) has the burden under section 103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. *See In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). The Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teaching. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must be found in the prior art, and not based on applicant’s disclosure.

It is respectfully submitted that a *prima facie* case of obviousness has not been established.

**Claims 1-8, 14, 18-23 and 29**

Applicants respectfully assert that the proposed combination is improper. It has been well established that teachings of references can be combined only if there is some suggestion or incentive to do so. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Accordingly, there must be a teaching in the relevant art which would suggest to a person having ordinary skill in that art the desirability of combining the features of *Monti* and *Hori*. *Monti* is concerned with “a need for capturing high higher resolution and/or higher quality images so that

the stored data contain more detail and use information for investigations.” (see col. 1, lines 54-56) *Hori* does not disclose capturing higher resolution and/or higher quality images, since the still images are generated as a result of capturing video images and “repeatedly read image data for one frame stored in the memory.” (see col. 5, lines 3-6, and also col. 1, lines 21-25 and col. 3, lines 27-30) Thus, the modifications to *Monti* as suggested by *Hori* would likely render *Monti* unsatisfactory of its intended purpose, which is symptomatic of an improper combination according to MPEP 2143.01.

Because the proposed combination is improper, Applicants respectfully request that the rejection to independent claims 1 and 18 be withdrawn. Further, because independent claims 1 and 18 are patentable over the art of record, Applicants respectfully submit that dependent claims 2-8 and 19-23 are allowable as a matter of law.

#### **Claims 17 and 32**

With regard to claims 17 and 32, the Office Action states the following:

However, Official Notice (MPEP § 2144.03) is taken that both the concepts and advantages of transferring stored high resolution high quality still image data to a printing device and using the stored high resolution high quality still image data to render a photograph are well known and expected in the art. At the time the invention was made, it would have been obvious to one with ordinary skill in the art to have transferring stored high resolution high quality still image data to a printing device and using the stored high resolution high quality still image data to render a photograph for the advantage producing a photographic album.

Applicants respectfully traverse this finding of well-known art and submit that the subject matter noted above should not be considered well known since the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support the conclusions, as required. The Manual of Patent



Examining Procedure (MPEP) defines the standard for taking official notice. As provided in MPEP § 2144.03:

Official notice without documentary evidence to support an examiner's conclusion is permissible only in some circumstances. While "official notice" may be relied on, these circumstances should be rare when an application is under final rejection or action under 37 CFR 1.113. Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. As noted by the court in *In re Ahlert*, 424, F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be "capable of such instant and unquestionable demonstration as to defy dispute" (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)).

As provided in MPEP § 2144.03 (emphasis added):

If applicant adequately traverses the examiner's assertion of official notice, *the examiner must provide documentary evidence in the next Office action* if the rejection is to be maintained. See 37 CFR 1.104(c)(2).

Accordingly, Applicants traverse the Examiner's use of official notice. Because of this traversal, the Examiner must support his finding with evidence, or withdraw the official notice determination.

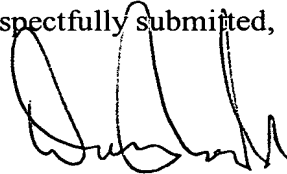
## **VII. Canceled Claims**

As identified above, claims 15, 16, 30, and 31 have been canceled from the application through this Response without prejudice, waiver, or disclaimer. Applicants reserve the right to present these canceled claims, or variants thereof, in continuing applications to be filed subsequently.

**CONCLUSION**

Applicants respectfully submit that Applicants' pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and official notice, and similarly interpreted statements, should not be considered well known since the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

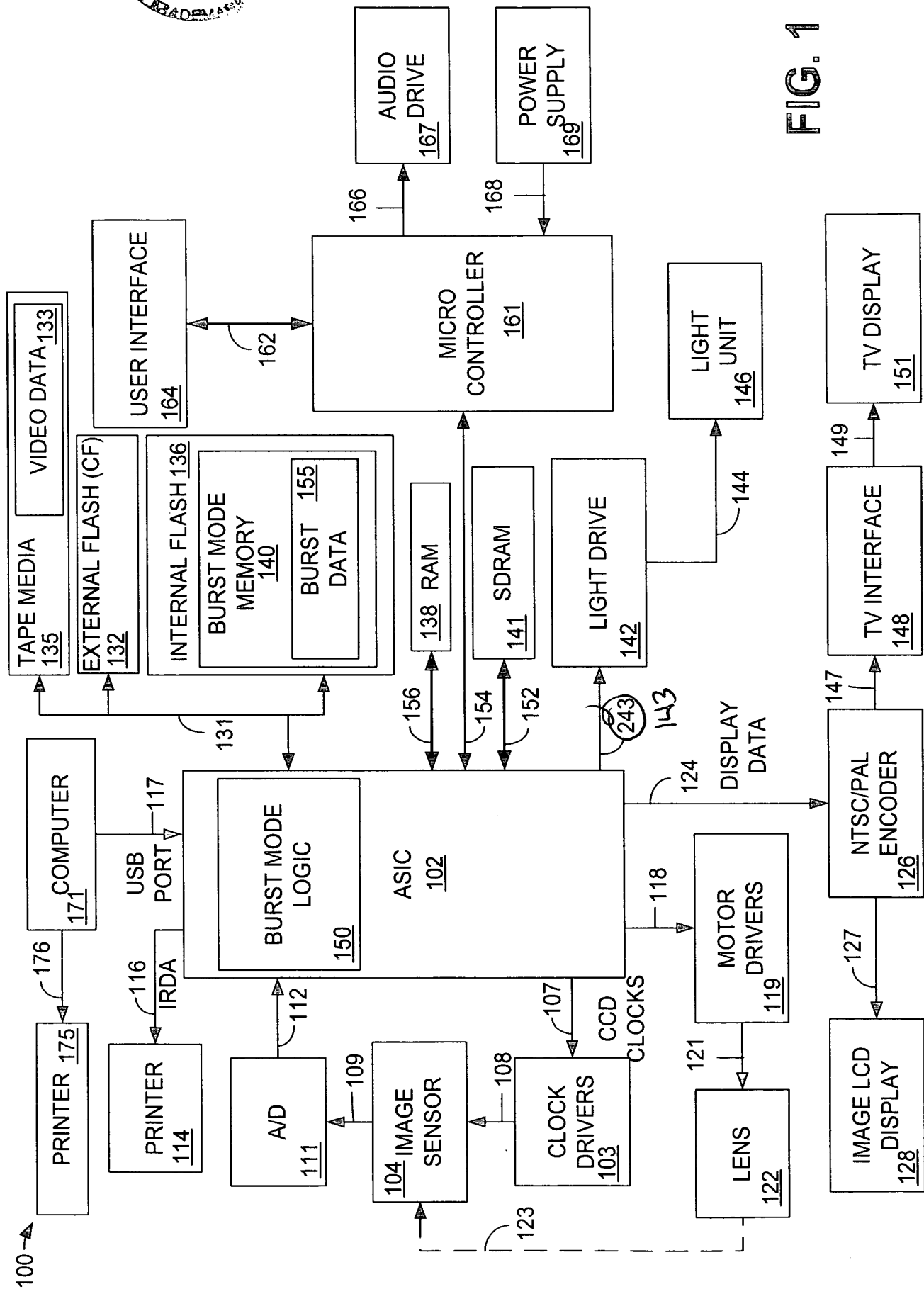


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**Drawings**

Applicants have enclosed a red-lined copy of FIG. 1 showing the amendment made to the figure, and have also enclosed clean-copy replacement sheet that incorporates the change noted in the red-lined figure.



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